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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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IN RE APPLICATION OF:

:

Bettina MOECKEL, et al.

: GROUP ART UNIT: 1636

SERIAL NO.: 09/826,909

:

FILED: APRIL 6, 2001

: EXAMINER: KATCHEVES

FOR: NEW NUCLEOTIDE SEQUENCES FOR ENCODING OF THE LYSR2-GENE

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action dated January 15, 2003, Applicants elect, with traverse, Group I, Claims 1-16, for further prosecution. In addition, Applicants elect, with traverse, dapA as a single disclosed species from the list of additional genes in Claims 13-15 of which Claim 13 reads on this elected species.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-16, drawn to polynucleotides, host cell and method of using host cell; and

Group II: Claims 17 and 18, drawn to a method of screening DNA.

If Group I is elected, then elect a single species from the list of genes presented in Claims 13-15.

Applicants elect, with traverse, Group I, Claims 1-16, for further prosecution. In addition, Applicants elect, with traverse, dapA as a single disclosed species from the list of additional genes in Claims 13-15 of which Claim 13 reads on this elected species.

Applicants note that the claims of Group II are directly dependent from the claims of Group I, and therefore it is improper to separate these groups. In an attempt to support restriction between Groups I and II, the Office merely states its conclusion, without providing sufficient reasons and/or examples to support this assertion. In fact, a clear relationship does exist since the claims of Group II are directly dependent from the claims of Group I. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Therefore, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the

species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species; Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Additionally, MPEP §821.04 states:

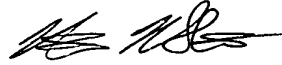
...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants further submit that this application is now in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

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